

REMARKS:

Claims 1-8 are pending in the patent application.

Claims 9-18 have been withdrawn.

Claims 1-3 have been rejected.

Claim 4 has been objected to.

Claims 5-8 have been allowed.

Claims 1-8 remain in the patent application.

Reconsideration of the claims is respectfully requested.

OBJECTIONS TO THE DRAWINGS

On Page 2 of the May 4, 2004 Office Action the Examiner objected to the drawings under 37 C.F.R. § 1.83(a) for allegedly failing “to show in Figure 41 how string-like connector 4200 and prosthesis 200 are attached to the cutting blade 4020 as described in the specification on page 50 line 15 to page 51 line 13. This makes it difficult to understand how the blade pulls the prosthesis into the pocket.” (May 4, 2004 Office Action, Page 2, Lines 9-13).

The Applicants respectfully submit that the specification clearly explains the structural relationship between the cutting blade 4020 (and its extension 4030) shown in FIGURE 41 and the extension 4300 of the cutting blade structure shown in FIGURE 42. However, the Applicants have amended the relevant portion of the specification in order to clarify the structural relationship.

The added text is a restatement of the definition of FIGURE 42 set forth on Page 18, Lines 4-6 of the specification. Therefore, no new matter has been added to the specification as a result of this amendment.

The Applicants respectfully submit that the clarification set forth in the amended specification meets the requirement that “Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing.” FIGURE 41 and FIGURE 42 clearly show the required structural detail described in the specification. For the reasons set forth above the Applicants respectfully submit that a drawing amendment is not necessary. The Applicants respectfully request that the Examiner withdraw the objection to the drawings.

CLAIM REJECTIONS – 35 U.S.C. § 102

On Page 2 of the May 5, 2004 Office Action the Examiner rejected Claims 1-2 under 35 U.S.C. § 102(b) as being anticipated by United States Patent Number 5,342,377 to *Lazerson*. On Pages 2-3 of the May 5, 2004 Office Action the Examiner rejected Claims 1-3 under 35 U.S.C. § 102(b) as being anticipated by United States Patent Number 3,609,864 to *Bassett*.

It is axiomatic that a prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *See, In re King*, 231 USPQ 136, 138 (Fed. Cir. 1986) (citing with approval, *Lindemann Maschinenfabrik v. American Hoist and Derrick*,

221 USPQ 481, 485 (Fed. Cir. 1984)); *In re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 USPQ 619, 621 (Fed. Cir. 1985).

With respect to Claims 1-2, a determination of anticipation in accordance with Section 102 requires that each feature claimed therein be described in sufficient detail in *Lazerson* to enable one of ordinary skill in the art to make and practice the claimed invention. With respect to Claims 1-3, a determination of anticipation in accordance with Section 102 requires that each feature claimed therein be described in sufficient detail in *Bassett* to enable one of ordinary skill in the art to make and practice the claimed invention.

A. The *Lazerson* Reference

The Applicants respectfully disagree with the Examiner's assertions regarding the subject matter disclosed in the *Lazerson* reference. The Applicants respectfully submit that the *Lazerson* reference does not show each and every limitation of the Applicants' invention. The Applicants direct the Examiner's attention to Claim 1, which contains unique and novel limitations:

1. (Original) A surgical blade for use with a surgical tool for making an incision in scleral tissue of an eye, said surgical blade comprising:
a rotatable support arm having a first end capable of being coupled to a drive shaft of said surgical tool that is capable of rotating said rotatable support arm; and
a curved cutting blade having a first end detachably coupled to a second end of said rotatable support arm, said curved cutting blade having a second end that is capable of being rotated by said surgical tool through said scleral tissue of said eye to make an incision

having the form of a scleral pocket that is capable of receiving a scleral eye implant prosthesis. (Emphasis added).

The rotating blade disclosed by *Lazerson* is not capable of being rotated into scleral tissue to form a scleral pocket in the manner disclosed and claimed in the present invention. The *Lazerson* reference discloses a simple cutting element 52 for cutting a circular opening in an anterior capsule wall in an eye through which a suction element may be inserted to draw out a cataract from within the capsule of the eye. That is, the *Lazerson* blade is designed to perform a capsulotomy on an eye. A comparison of the *Lazerson* blade with the blade of the Applicants' invention shows that the *Lazerson* blade is not capable of rotating to form a scleral pocket. The *Lazerson* blade does not rotate into the anterior capsule wall 18. Instead, the *Lazerson* blade rotates with respect to axle 54 so that the *Lazerson* blade can cut along the surface of anterior capsule wall 18 to form a circular path 76 of the type shown in FIGURE 13. The *Lazerson* blade is not capable of forming a scleral pocket by rotation of the blade through scleral tissue.

Further, the *Lazerson* reference does not disclose that the blade 60 is detachable from base portion 58. The *Lazerson* blade 60 could not perform its function if the *Lazerson* blade 60 were detached. The Applicants note that the Examiner stated that "The reader knows that the blade is detachable from the support arm in the embodiment shown in Figure 4, because Lazerson singles this embodiment out as being different from the embodiments shown in Figures 11 and 12, which have their blades and support arm 'forged . . . as a unitary piece'[Column 4, lines 35-37]."

(May 4, 2004 Office Action, Page 3, Lines 5-9). The Applicants respectfully traverse this assertion of the Examiner for the following reasons.

The *Lazerson* reference states that “In the embodiments of FIGS. 3, 3a and 4, the blade portion may comprise a back side 62, at least a portion of which is secured centrally to separate base portion or plate 58.” (Emphasis added). The blade 60 must be secured to plate 58 and thereby to axle 54. The fact that blade 60' and base portion 58' may be formed as a “unitary piece” does not necessarily imply that blade 60 is detachable. In fact, the *Lazerson* reference does not refer to blade 60 being detachable. This is because blade 60 could not function properly if it were ever detached.

It is clear that the *Lazerson* blade 60 is not capable of rotating into the surface of the material that it is cutting to form a scleral pocket of the type disclosed and claimed by the Applicants. Therefore, with respect to Claim 2, it is equally clear that the *Lazerson* blade 60 is not capable of making an “incision” in scleral tissue having the dimensions set forth in Claim 2.

For these reasons, the Applicants submit that the *Lazerson* reference does not anticipate Claim 1 and Claim 2 of the patent application. The Applicants respectfully request that the Examiner withdraw the rejections of Claim 1 and Claim 2 as having been anticipated by *Lazerson*.

B. The *Bassett* Reference

The Applicants respectfully disagree with the Examiner's assertions regarding the subject matter disclosed in the *Bassett* reference. The Applicants respectfully submit that the *Bassett*

reference does not show each and every limitation of the Applicants' invention. The Applicants again direct the Examiner's attention to Claim 1, which contains unique and novel limitations.

The Applicants agree that the surgical blade handle disclosed by *Bassett* is rotatable. However, the structure of the *Bassett* surgical blade handle is rotatable around the central axis of handle shell 28 and drive shaft 30. The *Bassett* blade can not be rotated down into the surface of the material that it is cutting to form a scleral pocket of the type disclosed and claimed by the Applicants.

The Examiner stated that the *Bassett* cutting blade 24 is "capable of being rotated in any way the user desires, including rotating the blade through body tissue such as scleral tissue." (May 4, 2004 Office Action, Page 3, Lines 18-20). The Applicants respectfully traverse this assertion of the Examiner because the *Bassett* cutting blade 24 can not be rotated "in any way the user desires." The *Bassett* cutting blade 24 is restricted to rotation around the central axis of handle shell 28 and drive shaft 30. The axial rotation of the *Bassett* cutting blade 24 is therefore not capable of rotating in a manner that will form a scleral pocket due to the rotation.

It is clear that the *Bassett* cutting blade 24 is not capable of rotating into the surface of the material that it is cutting to form a scleral pocket of the type disclosed and claimed by the Applicants. Therefore, with respect to Claim 2, it is equally clear that the *Bassett* cutting blade 24 is not capable of making an "incision" in scleral tissue having the dimensions set forth in Claim 2. The Examiner stated that "The specifications of the cut size are more dependent on the skill of the

surgeon than on the mechanical features of the invention.” (May 4, 2004 Office Action, Page 4, Lines 3-5). The Applicants respectfully traverse this assertion of the Examiner. The Applicants’ device is designed to allow a surgeon to make the very precise incisions that are required to properly form a scleral pocket. (Specification, Page 7, Line 16 to Page 8, Line 16). Therefore, the *Bassett* cutting blade 24 is not capable rotating to make a scleral pocket having the dimensions set forth in Claim 2.

Claim 3 is dependent on Claim 1. The *Bassett* cutting blade 24 does not have the limitations that are set forth in Claim 1. Therefore, the *Bassett* cutting blade 24 does not anticipate Claim 1 and also does not anticipate Claim 3.

For these reasons, the Applicants respectfully submit that the *Bassett* reference does not anticipate Claims 1-3 of the patent application. The Applicants respectfully request that the Examiner withdraw the rejections of Claims 1-3 as having been anticipated by *Bassett*.

The Applicants also respectfully request that the Examiner withdraw the objection to Claim 4 for the reasons that have been set forth above.

Claims 5-8 have been allowed. The Applicants acknowledge and accept the allowance of Claims 5-8.

The Applicants respectfully request that Claims 1-4 also be passed to allowance. The Applicants respectfully deny any position or averment of the Examiner that is not specifically addressed by the foregoing argument and response.

SUMMARY

If any issue arises, or if the Examiner has any suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at wmunck@davismunck.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: _____

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